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Mail Stop: Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 8, 2003.
By: [Signature] Printed: Jeannie G. Labra

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Walker et al.

Title: CDNAS CO-EXPRESSED WITH PLACENTAL STEROID SYNTHESIS
GENES

Serial No.: 09/996,952 Filing Date: November 27, 2001

Examiner: Hutson, R. Group Art Unit: 1652

Mail Stop: Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. §1.144 FROM REQUIREMENT FOR RESTRICTION

Sir:

This is a Petition under 37 C.F.R. §1.144 to review the Final Restriction Requirement made in the instant case in the Office Action mailed September 9, 2003. Applicants request that the Commissioner vacate the Final Restriction Requirement and require the Examiner, upon searching and examining SEQ ID NOs:1-9 relative to claim 1, vacate his requirement that claim 2, drawn to SEQ ID NOs:4, 6 and 7 of SEQ ID NOs:1-9, be limited in scope to the examination of only SEQ ID NO:7.

I. FACTS INVOLVED

In Response to a Restriction Requirement mailed June 4, 2003, applicants elected Group I drawn to claims 1, 2, 3, 9, 10, and 11. Applicants further elected the single sequence of SEQ ID NO:7 relative to the examination of these claims, with traverse, and asked for reconsideration of the species election requirement on the following grounds:

Applicants pointed out that MPEP § 803.04 states that when an application contains claims to combinations of polynucleotides (as the combination of SEQ ID NOs:1-9 in instant

claim 1) as well as claims drawn to individual sequences recited in alternative form (such as SEQ ID NOs:4, 6, and 7 of instant claim 2):

In applications containing all three claims set forth in examples (A)-(C), the Office will require restriction of the application to ten sequences for initial examination purposes. Based upon the finding of allowable sequences, claims limited to the allowable sequences as in example (A), all combinations, such as in examples (B) and (C), containing the allowable sequences and any patentably indistinct sequences will be rejoined and allowed. (Emphasis added)

Applicants submitted that since the combination of claim 1 contains less than ten sequences, all sequences of the combination, i.e., SEQ ID NOs:1-9 should be examined relative to all of claims 1-3 and 9-11 and properly requested reconsideration of the Restriction Requirement on these grounds.

In response to applicants arguments, the Examiner acknowledged in the Office Action mailed September 9, 2003 that all of SEQ ID NOs:1-9 would be examined relative to claim 1, however, that the examination of claim 2, and dependent claims 3 and 9-11, would be restricted to elected sequence SEQ ID NO:7 and has made the requirement final.

II. RECONSIDERATION OF THE RESTRICTION REQUIREMENT

Based on the paragraph of MPEP § 803.04 recited above, applicants submit that proper restriction in the instant case requires the examination of all of SEQ ID NOs:1-9 relative to both of claims 1 and 2, as well as to dependent claims 3 and 9-11, and that the Examiner's requirement for the examination of a single sequence relative to claim 2 and dependent claims 3 and 9-11 is improper and should be reversed.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. **09-0108**.

Respectfully submitted,

INCYTE CORPORATION

Date: December 8, 2003

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